

Application No.: 09/745,157  
Amendment dated: November 10, 2004  
Reply to Office Action of July 14, 2004  
Attorney Docket No.: 1006.01US

b.) Remarks

Claims 1-6 and 8-32 are pending in this application. Claims 1, 8, 10, 13, 21, 22, and 28 have been amended in various particulars.

Claims 1, 5, 7-12, 16-22 and 29-31 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,674,065 to Atia, *et al.* This rejection is respectfully traversed for the following reasons.

Claim 1, for example, of the '065 patent describes a combination of an electrostatically tunable optical filter, a filter tuning voltage generator, a photo detector, and a controller. Claim 3 adds, for example, that the voltage generator comprises a lookup table.

In contrast, claim 1, as amended, describes a combination of a tunable optical filter, a photo detector, a decision circuit that compares the electrical signal to a threshold, and a controller that is responsive to the decision circuit to identify spectral features in the input signal by comparing the spectral position of an instantaneous passband of a tunable filter to a response of the decision circuit to determine the spectral features of the input signal.

Neither claim 1 nor the other claims of the '065 patent shows or suggests the claimed decision circuit or the controller as claimed.

Thus, independent claim 1 is deemed patentably distinguishable from the claims of the '065 patent. For similar reasons, independent claims 21, 22 and 31 are also deemed distinguishable.

For the foregoing reasons, Applicants request that this obviousness-type double patenting rejection be withdrawn.

Claim 21 was rejected under 35 U.S.C. §112, second paragraph as being indefinite. Specifically, their antecedent basis for "channel inventory" was questioned.

Application No.: 09/745,157  
Amendment dated: November 10, 2004  
Reply to Office Action of July 14, 2004  
Attorney Docket No.: 1006.01US

Generally, independent claims 1, 21, and 22 have been amended to change channel inventor or inventory channels to spectral features. Moreover, the claimed WDM signal has been amended to instead be identified as the more general input signal.

In any event, the antecedent basis problem has been addressed in the new claim 31.

Claims 1, 14-16, 21, 22, 27, 28 and 31 were rejected under 35 U.S.C. 102(e) as being anticipated by Hall *et al.* (U.S. Patent No. 6,559,954). Claims 2-5, 9-12, 23 and 24 were rejected as being obvious over the Hall, *et al.* patent in view of the Vanoli, *et al.* Claims 6 and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Hall, *et al.* (U.S. Patent 6,559,943) in view of the Bach, *et al.* Claim 13 was rejected as being obvious over the Hall, *et al.* patent in view of Vanoli, *et al.* and Delavaux, *et al.*.

As described in the attached Declaration under Rule 131, the inventors had conceived of the present claimed invention prior to the filing date (December 14, 2000) of the Hall, *et al.* patent. Moreover, they diligently worked to the effective reduction to practice that is constituted by the filing of the instant application over the subsequent six days between the December 14, 2000 date and the filing date of the instant application, which was December 20, 2000. Thus, the Hall patent is not prior art.

Thus, the pending rejections are overcome. In short, with the removal of the Hall reference, none of the other references, either together or separately, shows or suggests the present claimed invention.

Application No.: 09/745,157  
Amendment dated: November 10, 2004  
Reply to Office Action of July 14, 2004  
Attorney Docket No.: 1006.01US

Applicants believe that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

By   
J. Grant Houston  
Registration No.: 35,900  
Tel.: 781 863 9991  
Fax: 781 863 9931

Lexington, Massachusetts 02421  
Date: November 10, 2004

Application No.: 09/745,157

Docket No. 1006.01-US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re:	Jeffrey A. Korn <i>et al.</i>	Confirmation No:	7176
Serial No:	09/745,157	Group:	2633
Filed:	December 20, 2000	Examiner:	Phan, Hanh
For:	Optical Band Scanning Monitor System and Method		
Customer No.:	25263		
Attorney Docket No.	1006.01US		

**DECLARATION UNDER 37 CFR §1.131**

**Commissioner for Patents**  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450

The invention described in the claims as pending in the captioned-application was conceived by us prior to December 14, 2000.

Moreover, between December 14, 2000 and the filing date of the instant application, December 20, 2000, we were diligently working with our patent attorney to draft and finalize the instant application. Specifically, for those six days, we were involved in the review and drafting of the specification and claims, in addition to the formulation of the drawings.

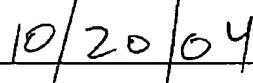
For example, the attached two figures were formulated, along with our patent attorney, to describe the instant invention on November 6, 2000. This establishes that in the month or more before filing, the inventors were working to draft the instant application.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further

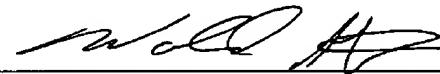
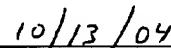
Application No.: 09/745,157

Docket No. 1006.01-US

that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

  
Jeffrey A. Korn  
10/20/04

Date

  
Walid A. Atia  
10/13/04

Date

